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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,150	12/22/2000	Compbell A. Moore	F-148	9765

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PITNEY BOWES INC.
35 WATERVIEW DRIVE
P.O. BOX 3000
MSC 26-22
SHELTON, CT 06484-8000

EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

JE

Office Action Summary

Application No.

09/747,150

Applicant(s)

MOORE ET AL.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/18/02</u> | 6) <input type="checkbox"/> Other: _____ |

1. Applicant should note the changes to patent practice and procedure:

A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;

B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and

C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.

2. The use of various trademark(s), for example: "StreamWeaver®", "ADDRESSRIGHT®", "DocuMatch®", have been noted in this application at paragraph located:

A) at page 2, lines 4-26, "Among the changes and requirements instituted ... printers. Applicant's print stream processing technology, for example, generally known by the trademark StreamWeaver®, substantially ... application-specific programs designed to operate with the document production system.";

B) at page 3, lines 1-10, "The advent of personal computers ... printers. It would be desirable to use such third-party applications in high volume document processing and mail systems such as, for example, the ADDRESSRIGHT® printing system produced by applicant without programmatically altering the third party application to accommodate the printer drivers of the printing system.";

C) at page 7, lines 8-13, "It will be understood that the individual components of the mailing system 10 are generic and are generally known in the mailing, document production and addressing arts. Integrated systems such as for example, the DocuMatch® system or ADDRESSRIGHT® system from Pitney Bowes Inc. are known to combine the features and capabilities of several of the components of the mailing system 10.";

D) between page 7, line 14, and page 8, line 30 "Turning now to Fig. 2, a flow chart ... for validity and compliance with USPS regulations. Software such as Pitney Bowes Smart Mailer™ mail management software operates to find duplicate addresses, detect undeliverable addresses and, where possible, corrects the errors in the address as

indicated by the address correction method step 120. In the ... the formatted document as indicated in the print document method step 128.”;

Any trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

2.1 Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

3. The drawings are objected to because

A) the following errors have been noted in the drawings:

(1) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description, note:

(a) reference legend 34 & 36 of fig. 1 as disclosed in the paragraph located between page 6, line 1 and page 7, line 7, “The mailing system 10 is comprised ... document. The print stream processor module also inputs the address information to an envelope formatter 32, which formats the envelope in accordance with information contained in an envelope definition file for placement of the destination address, return address, barcode, postage or other indicia or image to be printed on the envelope face. The envelope formatted information is passed to the IBIP generator to produce the IBIP postage indicia in accordance with the value indicated by the postage meter 38 and forwards the postage indicia image and address image to the envelope printer 40. The printed ... for placement into the delivery stream.”.

3.1 Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate

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figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The disclosure is objected to because of the following informalities:

A) applicant must update:

(1) the application data on page 1, "Reference is made to Application Serial Number _____ (Attorney Docket No. F-139), entitled METHOD AND APPARATUS FOR PRINTING AN INFORMATION-BASED INDICIA PROGRAM (IBIP) POSTAGE FROM A DOCUMENT INSERTER, assigned to the assignee of this application and filed on even date herewith.";

with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, --which is expired--, etc.

B) as required by 37 CFR § 1.84(p(5)) and 37 CFR § 1.121(e) the specification lacks an explicit reference to the nature of:

(1) reference legend(s):

(a) 34 & 36 of fig. 1 as disclosed in the paragraph located between page 6, line 1 and page 7, line 7, "The mailing system 10 is comprised ... document. The print stream processor module also inputs the address information to an envelope formatter 32, which formats the envelope in accordance with information contained in an envelope definition file for placement of the destination address, return address, barcode, postage or other indicia or image to be printed on the envelope face. The envelope formatted information is passed to the IBIP generator

to produce the IBIP postage indicia in accordance with the value indicated by the postage meter 38 and forwards the postage indicia image and address image to the envelope printer 40. The printed ... for placement into the delivery stream.”; and

(2) how the program proceeds after box(es):

(a) 118 of fig. 2 if the inquiry is "NO" in the paragraph between page 7, line 14, and page 8, line 30 “Turning now to Fig. 2, a flow chart showing ... the formatted document as indicated in the print document method step 128.”.

In this regard, it is noted that merely mentioning either a feature or a number with out mentioning the device or operation or number or feature relies on the drawing to provide support for the disclosure and not to aid in the understanding of the invention, as is the purpose of the drawings (37 CFR § 1.81(a,b)).

C) the following errors have been noted in the specification:

(1) the 1st paragraph on page 1 should read as follows: --Reference is made to [[Application Serial Number _____]] U. S. Patent number 6,621,591 (Attorney Docket No. F-139), entitled METHOD AND APPARATUS FOR PRINTING AN INFORMATION-BASED INDICIA PROGRAM (IBIP) POSTAGE FROM A DOCUMENT INSERTER, assigned to the assignee of this application and filed on even date herewith.--.

(2) (a) reference legend 34 & 36 of fig. 1 as disclosed in the paragraph located between page 6, line 1 and page 7, line 7, “The mailing system 10 is comprised of a CPU (central processing unit) 12 with an address database 14 cooperatively connected to a client application 16 and a word processing means, generally designated 18. The word processing means 18 is an application program, such as, for example, Microsoft® Word® or WordPerfect®, and has mail merge capabilities to produce an address-matched mailing wherein a document and envelope have a matched address and/or addressee. The text of the document or documents together with targeted selections or criteria typically

is input through the client application 16, and the address database 14 is generally in the form of a mailing list comprised of successive address fields. The address fields are typically parsed and combined by means of the CPU 12, which controls the word processing means 18 software application program and to print or forward each successive document to an application program printer driver interface 20. It will be understood that such word processing means have a master or template document wherein various fields are identified and during the processing mode the specific designated fields, such as the address fields and the addressee name are inserted from a formatted table to produce the desired document. The application program printer driver interface 20 sends all print data to the print stream processor module 28. In the mailing system 10, the address is parsed by the address parsing means 22 which separates the text information from the address information. The address information is checked for accuracy and compliance with USPS formatting regulations by the address validation means 24. If it is determined that the address is not valid, an address correction means 26 corrects the identified defects and forwards the validated address or corrected address as the case may be back to the print stream processor module 28. The print stream processor module information is output to a document printer 30 to produce the desired document. The print stream processor module also inputs the address information to an envelope formatter 32, which formats the envelope in accordance with information contained in an envelope definition file 34 for placement of the destination address, return address, barcode, postage or other indicia or image to be printed on the envelope face. The envelope formatted information is passed to the IBIP generator 36 to produce the IBIP postage indicia in accordance with the value indicated by the postage meter 38 and forwards the postage indicia image and address image to the envelope printer 40. The printed envelopes may be fed from the printer 40 to an inserter that inserts documents fed to it from the

document printer 30 to produce a matched mailpiece for placement into the delivery stream.”;

Appropriate correction is required.

5. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.52, 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

6. Claims 1-2 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6.1 In regard to claims 1-2, although one of ordinary skill at the time of the invention would know how to accomplish each of the individual recited actions/functions from the language of these claims, since, there is no clear and definite interconnection between one or more of the recited limitations of these claims, one of ordinary skill could not determine from the language of these claims whether or not they are in fact making and/or using the claimed invention. In this regard it is noted that from the language of these claims it is vague, indefinite and unclear:

A) in regard to section (b) of claims 1 & 2, and why the “addressed matched mail piece” is sent as “print stream” to a “print driver”, since the standard function of a print driver is to convert a stream of information to be printed into a print stream/file for a particular printer.

B) in regard to sections (b) and (c) of claims 1 & 2, and how and what prints to a print driver (section (b)) or sends to the print stream processor module (section (c)), since the invention as recited in these claims fails to create or generate the print stream from any source including the “addressed matched mail piece” data.

C) in regard to section (c) of claims 1 & 2, and how the “print stream information” maybe sent to a “print stream processor module”, since the invention as recited in these claims has not generated or received or set forth any “print stream

information” so that the “print stream information” can be sent to a “print stream processor module”.

D) in regard to section (d) of claims 1 & 2, and how the “print stream processor module” may used the “addressed matched mail piece” data, since the invention as recited in these claims has not provided or received or the “addressed matched mail piece” data to the “print stream processor module” so that it may be processed as recited in this section of claims 1 & 2.

E) in regard to sections (e) & (f) of claims 1 & 2 and why the “control code information” is removed from the “addressed matched mail piece”, since the invention as recited in this claim has not set forth any “information” that would replace the printer “control code information”, for example, “end of line”; “carriage return”; “line feed”; “page feed”; etc., that would instruct the printer how to accurately reproduce the address and textual information.

F) in regard to sections (e) of claims 1 & 2 and what removes the “control code information” may be removed, since the invention as recited in this claim has set forth a number of devices that could perform this function but the particular device that does perform this function has not been set forth.

G) in regard to sections (f) of claims 1 & 2 and what parses the “one or more addresses from the textual information”, since the invention as recited in this claim has set forth a number of devices that could perform this function but the particular device that does perform this function has not been set forth.

H) in regard to sections (g) of claim 1 (first occurrence) and claim 2 and what determines if the “one or more addresses is valid”, since the invention as recited in this claim has set forth a number of devices that could perform this function but the particular device that does perform this function has not been set forth.

I) in regard to sections (g) of claim 1 (second occurrence) and section (h) claim 2 and what sends the “valid address” to the “IBIP indicia generator”, since the invention as recited in this claim has set forth a number of devices that could perform

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this function but the particular device that does perform this function has not been set forth.

6.2 Claim 1 is confusing, since it contains two steps labeled as "(g)".

6.3 Claims 1 & 2 are inoperative and therefore lack utility for the recited purpose of the disclosed and claimed invention, since:

A) in regard to claim 1, the utility of the claimed invention as set forth in the preamble is a "method" of operating "a system for printing one or more addresses to a mailpiece, a method of printing postage and an address", however as recited in this claim, the addresses information and the postage are not in fact printed, hence the invention of claim 1 fails to accomplish the utility of printing postage and addresses.

B) in regard to claim 2, the utility of the claimed invention as set forth in the preamble is a "system for printing IBIP postage and an addresses to a mailpiece", however as recited in this claim, the addresses information and the postage are not in fact printed, hence the invention of claim 2 fails to accomplish the utility of printing postage and addresses.

For as the Court has specifically pointed out, claims must recite utility for the disclosed purpose of the invention, (General Electric Co. V. U.S., 198 U.S.P.Q. 65 (U.S. Court of Claims, 1978), Hanson v. Alpine Valley Ski Area 204 U.S.P.Q. 794 (District Court, E. D. Michigan, N. Div. 1978) and Banning v. Southwestern Bell Telephone C., 182 U.S.P.Q. 683 (SD Tex, 1974)).

6.4 For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

7. Claims 1 & 2 are rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. 6,621,591 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

7.1 The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

A) commonly recited functions (a) through (g) (second occurrence) of claim 1 and functions (a) through (h) of claim 2 which directly correspond to functions (a) through (h) of claim 1 of the patent.

B) although the instant claims does not recite printing functions (i) & (j) or inserting function (k) of claim 1 of the patent, it would have been obvious to one of ordinary skill at the time of the invention that the instant claimed invention would still cover the invention as recited in claim 1 of the patent, since the instant claimed invention would encompass any system that performed functions (a) through (g) (second occurrence) of claim 1 and functions (a) through (h) of claim 2 regardless of whether or not functions (i) through (k) are performed.

7.2 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

7.3 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

7.4 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

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8.1 Claims 1 & 2 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

8.1.1 The instant claims recite a system, (claim 2), and a method comprising a series of steps to be performed, (claim 1), which has a disclosed practical application in the technological or useful arts. Further, the instant claims do not merely define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon.

8.1.2 In regard to claims 1 & 2, the invention as set forth in these claims merely describes:

- A) the generation of mailing data including an addressed matched mail pieces comprising address and textual information as well as control data;
- B) sending the addressed matched mail piece to a print driver;
- C) sending a print stream to a print stream processor module;
- D) determining at the print stream processor module which data in the print stream is control data and which data in the print stream is address and textual;
- E) removing the control data from the print stream data;
- F) parsing the address data from the textual data while sending the address data to a correction component and the textual data to a document printer;
- G) determining if an address is valid and if the address is invalid then correcting the address; and
- H) generating an address image and an indicia image.

However, the process/system as recited in these claims does not require the result of either the claim as a whole or the manipulations of data as recited in these claims be applied in any manner so as to be tangibly used in a concrete manner and hence to produce a useful concrete and tangible result, that is a concrete and tangible application with in the technological or useful arts.

8.1.3 It is further noted that applicant has not recited in these claims a specific process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, which is either:

- A) altered or changed or modified by the invention recited in claims; or
- B) utilizes the result of the invention recited in these claims; or

C) is operated or controlled by the result of the invention recited in these claims.

8.1.4 It is further noted in regard to claims 1 & 2, that as claimed applicant has not claimed:

A) pre computer processing, since the claims fail to recited that the data, which originates from an unknown source, is manipulated or transformed/changed before it is processed; or

B) post computer processing, since the claims fail to recited that the data which represents the result of the claimed manipulation, is neither manipulated nor used nor changed by any device after it has been processed; or

C) a practical use of the claimed invention by any physical system or device or method outside of a statement of the intended use of the claimed invention; or

D) process steps or physical acts/operations that would affect the internal operation of a computer/machine as were found to be statutory in either In re McIlroy 170 USPQ 31 (CCPA, 1971) or In re Waldbaum 173 USPQ 430 (CCPA, 1972); or

E) process steps or physical acts/operations that would be considered as going beyond the manipulation of "abstract ideas" as were found to be non-statutory in In re Warmerdam 31 USPQ2d 1754 (CAFC, 1994); or

F) a concrete and tangible practical application of either:

(1) the invention as a whole; or

(2) the final results of the manipulations/actions with in the technological or useful arts;

note In re Sarkar 200 USPQ 132 (CCPA, 1978) where the process step of "constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model" was held to be so tenuous connected to the remaining process steps as to not be a process with in the scope of 35 U.S.C. § 101.

Hence, the invention of claims 1 & 2 is merely directed to an hypothetical mental exercise that manipulates an abstract idea of manipulating print data/information with out actually printing the final results of the manipulation of the print data and hence is with out a claimed concrete and tangible practical application of the abstract idea, (note In re Beauregard 35 USPQ2d 1383

(CAFC 1995) and the associated claims of U.S. Patent 5,710,578; and State Street Bank & Trust Co. v. Signature Financial Group Inc. 47 USPQ2d 1596 (CAFC 1998)).

8.1.5 It is further noted that the type/nature of either the data or the calculated numbers does not affect the operation of the claimed invention and hence are considered to be non function descriptive material, (note In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)).

8.1.6 In practical terms, claims define nonstatutory processes if they:

A) consist solely of mathematical operations without some claimed practical application (i.e., executing a “mathematical algorithm”); or

B) simply manipulate abstract ideas, e.g., a bid (Schrader, 22 F.3d at 293-94, 30 USPQ2d at 1458-59) or a bubble hierarchy (Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759),

without some claimed practical application of the mathematics or abstract idea.

8.1.7 In view of the above analysis claims 1 & 2, as a whole, are directed to an hypothetical mental exercise that merely manipulates mathematics or an abstract idea without a claimed concrete and tangible practical application of the mathematics or abstract idea, and hence are directed to non-statutory subject matter.

8.2 Claims 1 & 2 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

8.2.1 As set forth by the Court in:

A) In re Musgrave 167 USPQ 280 at 289-290 (CCPA 1970), “We cannot agree with the Board that these claims (all the steps of which can be carried out by the disclosed apparatus) are directed to non-statutory processes merely because some or all of the steps therein can also be carried out in or with the aid of the human mind or because it may be necessary for one performing the process to think. All that is necessary, in our view, to make a sequence of operational steps a statutory “process” within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to

promote the progress of “useful arts.” Cons. Art. 1, sec. 8.”, {emphasis added}; and

B) In re Sarkar 100 USPQ 132 @ 136-137 (CCPA 1978), echoing the Board of Appeals stated in regard to claim 14 “14. A method of locating an obstruction in an open channel to affect flow in a predetermined manner comprising:

a) obtaining the dimensions of said obstruction which affect the parameters of flow;

b) constructing a mathematical model of at least that portion of the open channel in which said obstruction is to be located in accordance with the method of claim 1 using those dimensions obtained in step (a) above;

c) adjusting the location of said obstruction within said mathematical model until the desired effect upon flow is obtained in said model; and thereafter

d) constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model.”;

and “Concerning claims 14-39 and the significance of “post-solution activity,” like building a bridge or dam, the board concluded: While it is true that the final step in each of these claims makes reference to the mathematical result achieved by performing the prior recited steps, we consider the connection to be so tenuous that the several steps recited in each claim when considered as a whole do not constitute a proper method under the statute.”, {emphasis added}.

8.2.2 Further, it is noted in regard to claims 14-39 of Sarkar, although step (d) of claim 14 of Sarkar references the result of step (c) of claim 14 of Sarkar it is clear from the language of step (c) of claim 14 of Sarkar that multiple adjustments to the location of the obstruction are required to be made until a location with the desired effect has been determined. Hence, the reference to constructing the obstruction at the “specified adjusted location” in step (d) of claim 14 of Sarkar is vague, indefinite and unclear in regard to which one of the possible

multiple adjusted locations of the obstruction that were used during step (c) of claim 14 of Sarkar would be used when constructing the obstruction as required by step (d) of Sarkar. Therefore, without a clear connection between step (d) of Sarkar and the remaining steps of claim 14 of Sarkar, the Board of Appeals and the Court held that these claims were not a process within the meaning of process as used in 35 U.S.C. § 101 and hence were directed to non-statutory subject matter.

8.2.3 As can be seen from claims 1 & 2, these claims are directed to a series of devices for performing various functions or steps/actions/functions, which as set forth above in regard to the rejection of claims 1 & 2 under 35 U.S.C. § 112 2nd paragraph, are not clearly and definitely interconnected to one another and therefore do not provide an operative useful machine/system or method/process within the meaning of machine or process as used in 35 U.S.C. § 101.

8.3 Claims 1 & 2 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter, since they lack substantial and practical utility.

A) it is respectfully noted that claims 1 & 2 lack utility for printing postage and address, since these functions are not recited as part of the claimed invention.

In view of the above, it is considered that the invention of claims 1 & 2 lack substantial and practical utility.

8.4 Claims 1 & 2 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter, since:

A) in regard to claims 1 & 2, these claims fail to comply with the "requirements this title, namely 35 U.S.C. § 112 2nd paragraph as set forth above.

B) in regard to claims {fill in}, these claims fail to comply with the "requirements this title, namely 35 U.S.C. § 102 as set forth below.

C) in regard to claims {fill in}, these claims fail to comply with the "requirements this title, namely 35 U.S.C. § 103 as set forth below.

9. The following is an Examiner's Statement of Reasons for Allowance:

A) the prior art, for example:

(1) Linzmayer which discloses that it is advantageous for large mailer to correct/clean their mailing lists in order to save money by reducing undeliverable mail.

(2) either Cordery et al (5,628,249) or Harman et al (5,684,706) or Bresnan et al (5,873,073) or Harvey et al (6,026,385) which discloses that an user may created a single document containing document text, address text and a postage indicia where the document, envelope and postage indicia are printed by separate individual printers. It is noted that Harvey et al (6,026,385) discloses that the created document/file contains all of the required formatting and control codes that are necessary for the printers to properly reproduce the various parts of the document.

B) however, in regard to claims 1 & 2, the prior art does not teach or suggest that the control codes are removed from the addressed matched mail pieces.

10. The examiner has cited prior art of interest, for example:

A) Watts which discloses that an user may use the macros of a word processor to created a template that is used to correctly position merged address data with the formatting and printer control codes that would place the address information in the correct location on an envelope.

B) the Direct Marketing article, which disclose the combination of a number of different mail merger, mail correction, etc. programs may be combined into one suite of programs.

D) either Kara (WO 97/14117 or 6,208,980) which discloses a single document containing document text, address text and a postage indicia may be generated and formatted that the postage indicia and address text appear in a location on the document that would be visible through a windowed envelope.

11. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

12.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

12.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

12.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

02/03/05


Edward R. Cosimano
Primary Examiner A.U. 3629